

REMARKS

In an Office Action dated October 16, 2003, the Examiner rejected claims 1-15, and 24¹ under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification; rejected claims 1-15, and 26 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,241,524 to Aoshima et al. ("Aoshima") in view of U.S. Patent No. 6,149,523 to Yamada ("Yamada"), and further in view of Applicants' purported Admission of Prior Art (AAPA).

In the Office Action, the Examiner asserted that the Supplemental Information Disclosure Statement ("IDS"), filed August 26, 2002, failed to comply with 37 C.F.R. § 1.98(a)(2). Accordingly, the Examiner refused to consider the documents cited therein. The Examiner asserts Applicants did not file copies of the documents with the IDS. Applicants disagree with the Examiner's assertion, and respectfully direct the Examiner's attention to the stamped postcard receipt (resubmitted in a prior Applicants' response, dated September 12, 2003, to provide a previously submitted translation of a Japanese Patent Office Search Report), which evidences that three documents were filed on August 28, 2002 as part of the IDS. Accordingly, as a courtesy to the Examiner, Applicants submit herewith another copy of the previously-filed Supplemental IDS, including the Japanese language Search Report, an English-language version of the Japanese Search Report, Japanese Publication No. 10-295935, the article entitled

1. On page 3, line 1 of the Office Action, the Examiner indicated claims 1-24 were rejected under 35 U.S.C. §112. However, as correctly indicated in the Office Action Summary, claims 1-15 and 26 are pending. To advance the prosecution of this application, Applicants will assume the Examiner intended to reject pending claims 1-15 and 26 under §112. If this assumption is incorrect, Applicants request the Examiner provide another non-final Office Action so Applicants may adequately address the rejection.

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"Game Music Fun Club: 1 on 1," and the stamped postcard indicating that these papers were in fact received by the U.S. Patent and Trademark Office on August 26, 2002. Applicants therefore respectfully request that the Examiner consider the documents cited in the Supplemental IDS. If the Examiner fails to receive any document listed in the IDS upon receipt of this response, Applicants respectfully request the Examiner immediately contact the undersigned so that any such document may be hand-carried directly to the Examiner.

In the Office Action, the Examiner rejected pending claims 1-15, and 26 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification. Applicants assert the Examiner has failed to establish a *prima facie* case of lack of written description and respectfully traverse this rejection.

Regarding claims 1, 15, and 26, the Examiner asserts that the specification does not disclose "the special action to which the user is given prompts was never before operable during a game," and "that the special action will become operable for the first time in the game."

Claim 1 recites, *inter alia*, a "prompt processing means . . . which provides training for a key operation corresponding to a special action of a displayed object of a game which was never before operable during the game."

The specification provides exemplary support for this feature, in stating "[the] practice mode is actuated by the protagonist character meeting a practice character incorporated in part of a situation from the RPG on the story screen." (See specification at page 14, lines 14-17). (emphasis added). Specifically, "a protagonist character 282 meets the practice character 284, and engages in a prescribed dialogue. The practice

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mode is started upon selecting Yes in response to a final question as to whether to receive training" (See specification at page 14, lines 20-24).

Claim 1 further recites, *inter alia*, "such that the special action becomes operable for a first time in the game after a play key operation correctly matches the key operation corresponding to the special action"

The specification provides exemplary support for this feature, as well, where it is stated that "a protagonist character 282 meets the practice character 284, and engages in a prescribed dialogue. The practice mode is started upon selecting Yes in response to a final question as to whether to receive training" (See specification at page 14, lines 20-24). (emphasis added). Applicants submit that one relevant definition for "meet" is "to be introduced." See American Heritage College Dictionary, Third Edition, 1993. Furthermore, the specification provides "[a]ccording to the actions of this protagonist character 292, it may also be determined to [sic] whether these actions match techniques being trained." (See specification at page 15, lines 15-18).

Accordingly, Applicants respectfully submit that the specification reasonably conveys all of the features of claim 1 to one of ordinary skill in the art. Accordingly, Applicants request the Examiner to withdraw the § 112, paragraph 1 rejection of claim 1. Claims 2-7 and 9-12 depend from claim 1 and are allowable for at least the reasons provided in claim 1. Independent claims 9 and 15 include recitations similar to claim 1 and are allowable for at least the reasons provided for allowable claim 1. Claims 13, 14, and 26 depend from claim 15 and are allowable for at least the reasons provided for allowable claim 15.

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In making various references to the specification drawings set forth herein, it is to be understood that Applicants are in no way intending to limit the scope of the claims to the exemplary embodiments shown in the drawings and described in the specification. Rather, Applicants expressly affirm that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation and applicable case law.

In the Office Action, the Examiner rejected claims 1-15 and 26 under 35 U.S.C. § 103(a) as unpatentable over Aoshima in view of Yamada, and further in view of AAPA. Applicants respectfully traverse this rejection because the Examiner failed to establish a prima facie case of obviousness under §103(a). In order to maintain a valid §103(a) rejection, each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. §2143.03 (8th ed. 2001).) Second, there must be some suggestion or motivation, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, not in Applicant's disclosure." (M.P.E.P. § 2143 (8th ed. 2001).)

Regarding claim 1, Aoshima merely teaches a game apparatus that uses an operational state judging section for judging an operational state from an operation history of the player to select advice data appropriate to the player (See Aoshima, col. 2, lines 46-50). Skilled players may therefore selectively proceed through a game without receiving the advice that is meant for beginners (See Aoshima, col. 3, lines 1-

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22). In particular, a skilled player may command an "advice terminating means" that prevents advice messages from being displayed in an advice window. (See Aoshima, col. 5, lines 30-34). In other words, Aoshima's game apparatus allows a skilled player to perform all the operations known to him without receiving any advice.

Moreover, Yamada merely teaches a game machine which provides an image synthesis method for synthesizing a game image and determines whether or not an input sequence matches a given standard sequence. (See Yamada, col. 1, lines 51-55). In particular, Yamada teaches a game device that includes a "training mode" that provides visual feedback to a user in order to learn a "special technique." (See Yamada, col. 2, lines 46-60; Figs. 1B and 1C). In the training mode, Yamada's game device displays controller sequences and indicates which input operations for the special technique were successful. (See Yamada, col. 5, lines 55-59). The special techniques are available to the user at any time in order to have an advantage over an opponent in the game. (See Yamada, col. 4, lines 54-61.) Yamada's game device merely includes a training mode to allow a user to become familiar with a special technique. (See Yamada, col. 2, lines 46-60; Figs. 1B and 1C). In Yamada's game device, once a user has learned a special technique, the user may perform that special technique at any time during the game. (See Yamada, col. 3, lines 54-62.)

Accordingly, Aoshima and Yamada, fail to teach or suggest, at least, "said prompt relating to an action of the displayed object other than the special action and suggesting the key operation to a player via output means, such that the special action becomes operable for a first time in the game after a player key operation correctly matches the key operation corresponding to the special action suggested by the

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prompt," as recited in claim 1. Furthermore, the Examiner admits these (and several other) deficiencies of Aoshima and Yamada in the Office Action at page 7, lines 14-15. (emphasis added.)

In this respect, the Examiner attempted to overcome the admitted deficiencies of Aoshima and Yamada by combining them with AAPA. AAPA, however, fails to cure the deficiencies of these references. AAPA merely teaches providing a player with a scene for training in key operations, called a practice mode. (See specification at page 2, lines 4-7.) "The player can enter this mode during or before the start of the action game as he or she desires." (See specification at page 2, lines 7-9.) In practice mode, "the types of keys to be operated and the order in which they are operated or pressed are displayed on the screen in a window format." (See specification at page 2, lines 10-12.) "After a certain amount of practice, the player exits this practice mode and can begin or return to the scene of the action game." (See specification at page 2, lines 20-22.) (emphasis added.)

In summary, Aoshima, Yamada, and AAPA, either separately or in any combination, fail to teach or suggest at least "said prompt relating to an action of the displayed object other than the special action and suggesting the key operation to a player via output means, such that the special action becomes operable for a first time in the game after a player key operation correctly matches the key operation corresponding to the special action suggested by the prompt" as recited in claim 1. (emphasis added.)

Furthermore, Applicants respectfully submit that there is no motivation demonstrated by the Examiner for the combination of Aoshima, Yamada, and AAPA,

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nor has the Examiner demonstrated any reasonable chance of success, because the combination fails to teach all of the features recited in claim 1.

Accordingly, Applicants respectfully request that the Examiner withdraw the §103(a) rejection of claim 1. Claims 2-7, 9-12 depend from claim 1 and are allowable for at least the reasons provided in allowable claim 1. Independent claims 9 and 15 include recitations similar to claim 1 and are allowable for at least the reasons provided for allowable claim 1. Claims 13, 14, and 26 depend from claim 15 and are allowable for at least the reasons provided for allowable claim 15.

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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